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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,967	01/22/2004	Gary Martin Zelman	4078	7898
23388	7590	08/31/2005	EXAMINER	
TROJAN LAW OFFICES			MAI, HUY KIM	
9250 WILSHIRE BLVD			ART UNIT	
SUITE 325			PAPER NUMBER	
BEVERLY HILLS, CA 90212			2873	

DATE MAILED: 08/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/763,967

Applicant(s)

ZELMAN, GARY MARTIN

Examiner

Huy K. Mai

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 15-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. The amendment filed Feb. 9, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The limitations “said magnetic material **capable of fitting solely** (emphasized) below and mating with magnetic material on said conventional eyeglasses”.

Applicant is required to cancel the new matter in the reply to this Office Action.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 15-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to support for the limitations “said magnetic material **capable of fitting solely** (emphasized) below and mating with magnetic material on said conventional eyeglasses” now claimed in the independent claims 15,24-28. (Note: claims 24,25,27,28 are used equivalent terms such as being secured, being mounted, mounting). Nowhere in the specification provides support for such the limitations. In fact the drawings, particular Fig. 4, show the

Art Unit: 2873

magnetic material on the auxiliary eyeglasses not only being “capable of fitting below” but also “capable of fitting above” and mating with magnetic material on said conventional eyeglasses because due to the characteristics of the magnetic attractive force, the first magnets fitted above or below the second magnets would provide the same magnetic attractive force. Therefore the magnetic material 26 in Fig. 4 can be capable of fitting above or below and mating with magnetic material on said conventional eyeglasses instead of “capable of fitting solely below” as now claimed. The applicant does not demonstrate how the magnetic material on the auxiliary eyeglasses capable of fitting solely below, but *incapable of fitting above* (emphasized) magnetic material on said conventional eyeglasses.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 15-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chao (5,568,207).

The limitations in claims 15-25,27,28 are shown in Chao's Figs. 3-7, column 2, line 33 through column 3, line 10, except for the first (emphasized) magnets of the auxiliary eyeglasses are fitted above the second (emphasized) magnets of conventional eyeglasses instead of said magnetic material (of auxiliary eyeglasses) capable of fitting solely below and mating with magnetic material on said conventional eyeglasses as claimed by the Applicant. Due to the

Art Unit: 2873

characteristic of the magnetic attractive force, the first magnets capable of fitting above or below the second magnets would provide the same magnetic attractive force. It would have been obvious at the time the invention was made to a person having ordinary skill in this art to attach the auxiliary eyeglasses to the conventional eyeglasses in the Chao reference by fitting the magnetic material below and mating with the magnetic material of the conventional eyeglasses since the magnetic material on the auxiliary eyeglasses not only being “capable of fitting solely below” but also “capable of fitting solely above” and mating with magnetic material on said conventional eyeglasses because due to the characteristics of the magnetic attractive. Such a fitting of the first magnets would not change the scope of the invention in the Chao reference. (See *In re Japike*, 86 USPQ 70 (CCPA 1950) for the difference or shifted location in the device would not change the scope of the invention from the prior art.)

(NOTE: It is advised that the applicant should review the long prosecution of examination in the parent application serial no.: 09/184,694 before amending claims and/or responding to the Office action.)

Regarding claim 26, it should be noted that although claim 26 “method claim”, the method steps consist of the broad steps of “providing” and “mating” and therefore these steps would be inherently satisfied by the apparatus of the reference as modified.

### ***Response to Arguments***

6. Applicant's arguments filed Jun. 20, 2005 have been fully considered but they are not persuasive. The applicant argues that in page 8 that “New matter is defined as matter that is not disclosed in the original specification, claims or drawings. See MPEP 608.04(a) (emphasis added). Applicant respectfully traverses the Examiner's new matter objection because the language of the Applicant's claims, as currently amended,

Art Unit: 2873

is in fact supported by the original specification and drawings and does not introduce any new matter into the disclosure” and “Also, Figure 3 shows that the magnetic material (26) fits only below the magnetic material (30) and that no part of the magnetic material (26) is above the magnetic material (30)”; and concludes that “For this reason, the Applicant submits that the Applicant's disclosure in Figures 1-3 adequately supports Applicant's newly amended claims”. It appears that applicant could not point out wherein the specification and the drawing support for the limitations “said magnetic material **capable of fitting solely** (emphasized) below and mating with magnetic material on said conventional eyeglasses” now claimed. The applicant points out Fig.3; however, this Fig. 3 only show “the magnetic material (26) fits below the magnetic material (30)”. The Fig.3 cannot show the operational language “**capable of .... solely...**”, as claimed. The applicant does not demonstrate how the magnetic material on the auxiliary eyeglasses capable of fitting solely below, but *incapable of fitting above* (emphasized) magnetic material on said conventional eyeglasses. In another word, neither the specification nor the drawings provide support for the limitations “said magnetic material **capable of fitting solely** (emphasized) below and mating with magnetic material on said conventional eyeglasses” now claimed.

7. Applicant's arguments filed Jun. 20, 2005 have been fully considered but they are not persuasive. The applicant argues that “As a result, the Examiner cannot once again use the ‘207 reference against the Applicant's claims containing the “capable of solely below” limitation because the issue of top versus bottom obviousness has already been decided in the Applicant's favor”. This arguments are not true. The prosecution in the parent application 09/184,684 has never discussed such an operation language “**capable of .... solely...**” . The applicant is requested to provide the evident to support for such argument.

### ***Conclusion***

Art Unit: 2873

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.



Huy Mai  
Primary Examiner  
Art Unit 2873

Application/Control Number: 10/763,967

Page 7

Art Unit: 2873

HKM/

August 30, 2005